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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,186	01/24/2005	Shigetoshi Kadota	043157	3671

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EXAMINER

FRAZIER, BARBARA S

ART UNIT	PAPER NUMBER
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1609

MAIL DATE	DELIVERY MODE
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08/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,186	Applicant(s) KADOTA ET AL.	
	Examiner Barbara Frazier	Art Unit 1609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Entry of Amendments

1. Applicants' amendments filed 06 April 2007 have been entered. Claims 2-8 have been canceled. Claims 1 and 9 are now pending.

Election/Restrictions

2. Applicant's election of Group I and the species of taxiresinol in the reply filed on 06 April 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "both with the carbon number 1 to 4" on line 4 of the claim is unclear, since only the alkyloxy group of R2 can contain carbon. It is not clear if the word "both" is referring to just the alkyloxy group of R2, or to something else as well.

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6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “comprising said compound shown in the formula (1)” on line 1 of the claim is unclear, because no “compound shown in the formula (1)” exists in independent claim 9. The claim, as it now reads, is incomplete. To be complete, the claim should include the compound shown in the formula (1) in the claim (similar to claim 1).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mujumdar et al., Indian J. Chem., vol. 10, 677-680 (1972).

Mujumdar et al. disclose the compound taxiresinol. The compound anticipates the compositions of claims 1 and 9 comprising taxiresinol. The descriptions of “hypoglycaemic agent” (claim 1) and “hepatoprotective agent” (claim 9) are intended use limitations and not given any patentable weight because they are not deemed to limit the claims. Therefore, the prior art’s description of taxiresinol anticipates the compositions comprising taxiresinol.

9. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Shen et al., Chinese Pharmaceutical Journal (Taipei), vol. 49, No. 5-6, 1997 pp. 285-296.

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Shen et al. disclose the compound taxiresinol (abstract, line 2, page 285, and compound 7, page 288) exhibiting potent cytotoxicities. The compound anticipates the compositions of claims 1 and 9 comprising taxiresinol. The descriptions of “hypoglycaemic agent” (claim 1) and “hepatoprotective agent” (claim 9) are intended use limitations and not given any patentable weight because they are not deemed to limit the claims. Therefore, the prior art’s description of taxiresinol anticipates the compositions comprising taxiresinol.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ahotupa et al. disclose the use of the lignan hydroxymatairesinol in a food product as an anticancer agent. Rao et al. (USP 6,649,650) disclose the use of the lignans hydroxymatairesinol and wikstromol for the treatment of cancer. Rao et al. (USP 6,537,593) disclose the use of the lignan wikstromol as a hepatoprotective agent. Kupeli et al. disclose five lignans having anti-inflammatory and antinociceptive activity. Nguyen et al. (2004) disclose the hepatoprotective effect of taxiresinol and (7'R)-7'-hydroxylariciresinol.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Frazier whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 8am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

 8/2/07
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER